IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	)
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Richard SCHWARTZ et al.	) Group Art Unit: 2626
	)
Application No.: 09/656,264	) Examiner: Opsasnick, M.
	)
Filed: September 6, 2000	)
	)
For: SYSTEMS AND METHODS FOR	) Confirmation No.: 9095
PROVIDING AUTOMATED	)
DIRECTORY ASSISTANCE	) **Mail Stop AF**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Applicants request a pre-appeal brief review of the Final Office Action dated May 12, 2006. This Request is being filed concurrently with a Notice of Appeal.

I. Requirements For Submitting a Pre-Appeal Brief Request for Review

Applicants have met each of the requirements for a pre-appeal brief review of the rejections set forth in the Final Office Action mailed May 12, 2006. The application has been at least twice rejected. Applicants have filed a Notice of Appeal with this Request, and have not yet filed an Appeal Brief. Lastly, Applicants submit a Pre-Appeal Brief Request for Review that is five (5) or less pages in length and sets forth legal or factual deficiencies in the rejections. *See* Official Gazette Notice, July 12, 2005. Therefore, Applicants request review of the Examiner's rejections in the Final Office Action for the following reasons.

II. The Rejection of Claims 53-55 is Legally Deficient Because the Examiner Failed to Address the Recitations of these Claims

In the Final Office Action, the Examiner rejected claim 55 for the same reason set forth with respect to the rejection of claim 1. (Final OA at 2). As previously noted in the response filed February 27, 2006 ("*Reply*"), however, claim 55 includes recitations not found in claim 1. (*Reply* at 17.) For example, claim 55 includes the additional recitation of: "defining at least one required word associated with the listing." This feature is not recited in claim 1.

37 C.F.R. § 1.104(c) requires the Examiner to provide more than merely stating a reference meets the limitations of a rejected claim. "When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified." 37 C.F.R. § 1.104(c)(2). In this case, not only are the references asserted by the Examiner complex and describe many different embodiments, the Examiner improperly ignores recitations of independent claim 55. As such, the Examiner's rejection of claim 55 under 35 U.S.C. § 103(a) does not meet the requirements of 37 C.F.R. § 1.104, and thus is improper. Further, to establish *prima facie* obviousness under 35 U.S.C. § 103(a), the Examiner must show, *inter alia,* that the applied references, taken alone or in combination, teach or suggest each and every element recited in the claims. M.P.E.P. § 2143. Here, by ignoring certain recitations of claim 55, the Examiner has failed to show how the cited art teaches or suggests these recitations of this claim. As a result, the rejection of this claim does not meet the requirements of at least M.P.E.P. § 2143 and 35 U.S.C. § 103(a), and thus is improper.

The same legal deficiencies are found in the rejection of claim 53 and 54. The Examiner rejects claims 53 and 54 for the same reason set forth for claim 1 (Final OA at 2), however, claims 53 and 54 includes recitations not found in claim 1, such as "receiving a request for a telephone number from a caller, the request ... including a location and listing corresponding to the telephone number." Again, by ignoring these recitations of claims 53 and 54, the Examiner has failed to show how the cited art teaches or suggests the claimed invention recited in claims 53 and 54.

Accordingly, the rejection of claims 53-55 is legally deficient.

III. The Rejection of Claims 1-4, 6-30, and 53-55 is Legally Deficient Because the Examiner Failed to Establish a _Prima Facie_ Case of Obviousness

A _prima facie_ case of obviousness has not been established at least because the combination of _Gupta_ with _Kahn_ is improper. It is improper to combine references where the references teach away from their combination. (M.P.E.P. § 2145(X)(D)(2)).

Gupta is directed toward a directory assistance system that must handle a large number of individual callers, while _Kahn_ discloses "all speech recognition require[s] significant training to establish an acoustic model of a particular user" (_Kahn_, col. 8, lines 56-58), and further indicates that this training requires "20 minutes of audio usually obtained by the user reading a canned text" (_Kahn_, col. 8, lines 59-61). The Examiner's proposed combination would, at a minimum, require training an acoustic model for 20 minutes for each caller to the directory assistance system. One of ordinary skill in the art will immediately recognize this as a teaching away from the proposed combination.

Further, it is improper to combine references when the combination renders the prior art unsatisfactory for its intended purpose. (M.P.E.P. § 2143.01(V)). Users of a directory assistance system clearly do not wish to spend 20 minutes training an acoustic model in order to simply make a telephone call, and _Gupta_ indicates as much, stating: "[t]he search may be done in several steps in order to maximi[z]e the probability of obtaining the correct result in the shortest possible time and most preferably in real-time." (_Gupta_, col. 6, lines 47-50). For much the same reasons that _Gupta_ and _Kahn_ teach away from one another, the Examiner's proposed combination renders _Gupta_ unworkable.

In addition to these failings, the prior art references fail to teach or suggest each and every claim element recited by the claims. Claim 1, for example, recites "a listing retrieval module configured to retrieve at least one listing corresponding to [an audible request for a telephone number]." The Examiner cites Fig. 3, subblocks 404-406 of _Gupta_ to support the proposition that the reference teaches this subject matter (Office Action at p. 2). However, the Examiner does not consider that _Gupta_ is directed toward a system for determining the locality of a requested listing, and not the listing itself (_Gupta_, col. 9, lines 23-25).

More specifically, _Gupta_ is directed toward using locality information contained in the phone number of a person calling to request a telephone number, as well as locality information contained in the number that the person dialed to request the phone number, to more accurately predict the locality in which the requested listing resides. (_Gupta_, col. 9, lines 25-28). Indeed, the cited portions of _Gupta_ do not disclose retrieving a "listing

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corresponding to [an audible request for a telephone number]." Instead, these portions of *Gupta* disclose retrieving <u>locality</u> information from the telephone number of the <u>caller</u>, in order to more accurately determine the <u>location</u> where the requested listing resides. (*Gupta* col. 11, lines 17-25).

This erroneous application of *Gupta* pervades the entire Final Office Action, as the Examiner continually relies on *Gupta* to teach claim recitations directed towards "listings," while the cited portions of *Gupta* refer to locations. Claim 1, for example, further recites "a speech recognition module configured to receive an audible request for a telephone number from a caller and generate a transcript from the audible request." The Examiner improperly applies *Gupta*'s teachings related to locality information to the claimed "request for a telephone number," citing *Gupta*, col. 6 lines 35-50 as teaching the claimed request for a telephone number. (Final OA at p. 2). The cited portions of *Gupta* merely disclose "convert[ing] the spoken utterance into an electric signal and transmit[ting] the signal to the speech recognition unit 100 ... the search block 104 includes a speech recognition dictionary that is scored in order to find possible matches to the spoken utterance." (*Gupta*, col. 6, lines 36-47), and the speech recognition dictionary is limited to localities.

Indeed, if the Examiner's allegations were correct, one would expect to find references to the spoken utterance in *Gupta* as a request for a phone number, and references to the speech recognition dictionary as containing some words associated with specific listings. This is simply not the case. Instead, the utterance is matched against a speech recognition dictionary containing only localities, such as Montreal, Quebec, and Ottawa. (*Gupta* col. 8, lines 18-59, col. 10 lines 1-64). *Gupta*, therefore, cannot be read to teach a transcript from "an audible request for a telephone number," as recited by claim 1. Independent claims 17, 29, 30, and 53-55 are distinguishable from the cited art for the same reasons discussed herein with respect to claim 1.

The Examiner has also failed to establish that the prior art teaches the recitations of the dependent claims. Consider claims 3, 10, 18, and 19, each of which recite an "n-gram grammar." As disclosed in the specification at p. 13, the "n-gram grammar estimates the likelihood of each single word, each pair of words, each triplet of words, etc." The Examiner cites only *Gupta*'s disclosure of "a data structure containing orthographies that can be mapped onto a spoken utterance on the basis of ... a linguistic or grammar model" in alleging that the reference teaches this subject matter (Office Action at p. 4). This is clearly deficient as the claims do not simply recite a "grammar," but rather an "n-gram

grammar." The phrase "n-gram grammar," or a reasonable synonym or description of such a grammar, does not appear once in the cited references. Moreover, claims 10 and 18 recite "creat[ing] an n-gram grammar for the telephone numbers." *Gupta* fails to teach creating a grammar at all, and moreover any grammar created by *Gupta* would be a grammar for recognition of spoken localities, and not the claimed "n-gram grammar for the telephone numbers."

Claim 14, for example, recites "generate a training transcript for one of the prior requests using the loose grammar." In rejecting claim 14, the Examiner alleges that *Gupta* teaches "training the transcript according to the grammar." (Office Action at p. 5). Even assuming *Gupta* teaches "training a transcript," this is distinguishable from the claimed "generate a training transcript." Moreover, the cited portions of *Gupta* merely disclose using "a-priori probabilities" for mapping an utterance. The phrase "a-priori" does not imply "training," but rather that the probabilities used in *Gupta* are known beforehand based on some set of data.

For at least these reasons, the Examiner has not established a *prima facie* case of obviousness with respect to claims 1-4, 6-30, and 53-55, and thus, the rejection of these claims under 35 U.S.C. § 103(a) is improper and should be withdrawn.

V.   Conclusion

Because the Examiner's rejections of claims 1-4, 6-30, and 53-55 include legal deficiencies, Applicants are entitled to a pre-appeal brief review of the Final Office Action. Based on the foregoing arguments, Applicants respectfully request that the rejection of these claims be withdrawn and the claims allowed.

Respectfully submitted,

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Dated: September 12, 2006   By:
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